

**Remarks/Arguments:**

**Claim Status**

Claims 7-9 and 11-13 are currently pending. Claim 10 has been cancelled without prejudice or disclaimer of the subject matter thereof.

**Claim Objections**

Claim 7 has been amended to address the errors identified in the Office Action. Withdrawal of the objections is respectfully requested.

**Claim Rejections Under 35 U.S.C. § 112**

Claims 7-9 and 11-13 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 7 and 12 have been amended. This rejection should now be moot.

The language of claim 7 has been amended for the purpose of clarity and consistency. To aid the Examiner's understanding, the Applicant's representative has added item numbers to the language used in claim 7. The item numbers identified below are applicable to one exemplary embodiment of the invention. Accordingly, the features recited in claim 7 are not limited to the item numbers identified below, nor the drawings to which they refer.

Internal combustion engine having cylinder groups and using dry-sump-principle pressure lubrication, comprising:

a crankcase 2, 4 having an oil suction space 12 in a lower part thereof for collecting lubricant oil;

an oil return pump 24 that is configured to convey lubricant oil out of the oil suction space 12 through an oil suction line 26;

an annular space 32, 34 arranged around cylinder groups, wherein the oil suction line 26 of the oil return pump 24 delivers lubricant oil into the annular space 32, 34, and wherein the annular space 32, 34 is exposed to the atmosphere for defoaming the lubricant oil collected within the annular space 32, 34;

an oil supply container 16, 18 that is fluidly coupled to the annular space 32, 34 for receiving defoamed lubricant oil from the annular space 32, 34; and

a main delivery pump 48 configured for conveying lubricant oil from the oil supply container 16, 18 to consumers of the lubricant oil,

wherein the oil supply container 16, 18 is separate from the oil suction space 12 and is positioned to at least partially surround the oil suction space 12, at least a portion of the oil supply container 16, 18 being disposed at an elevation beneath the oil suction space 12.

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 7, 8 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spangenberg (U.S. Patent No. 2,443,875) in view of Krotky (U.S. Patent No. 5,842,447). Applicant respectfully requests reconsideration of the rejection of these claims and respectfully submits that these claims are patentable over Spangenberg in view of Krotky for the reasons set forth below.

Independent claim 7 recites at least the following features that are neither disclosed nor suggested by Spangenberg and/or Krotky, namely:

an annular space arranged around cylinder groups, wherein the oil suction line of the oil return pump delivers lubricant oil into the annular space, and wherein the annular space is fluidly coupled to a vent connection that is exposed to the atmosphere for defoaming the lubricant oil collected within the annular space;

an oil supply container that is fluidly coupled to the annular space for receiving defoamed lubricant oil from the annular space; and

... wherein the oil supply container is separate from the oil suction space and is positioned to at least partially surround the oil suction space, at least a portion of the oil supply container being disposed at an elevation beneath the oil suction space.

Spangenberg's container (item 10) does not surround the oil sump (item 21). Furthermore, Spangenberg's container 10 is not disposed at an elevation beneath the oil sumps 21 and 22.

In addition, although Krotky discloses an oil jacket (item 8) disposed around cylinder groups, the oil jacket 8 does not include provisions for coupling with a vent connection that is exposed to the atmosphere to defoam lubricant oil collected within the oil jacket 8. While

Spangenberg teaches a centrifugal separator (item 34) for defoaming oil, the centrifugal separator 34 receives oil from the sumps 21 and 22 and, thus, would not be coupled to Krotky's oil jacket 8 if Krotky's cylinder block were incorporated into Spangenberg's lubricating system. Moreover, Krotky's oil jacket 8 includes no provisions for coupling to a vent connection that is exposed to the atmosphere. As background, in order to spare oil/air separators, the Applicant's annular space is fluidly coupled to a vent connection that is exposed to the atmosphere for defoaming the lubricant oil.

Moreover, incorporating Krotky's cylinder block into Spangenberg's lubricating system would not yield "an oil supply container that is fluidly coupled to the annular space for receiving defoamed lubricant oil from the annular space," as recited in claim 7, because the oil jacket 8 would not be fluidly coupled to the container 10 for receiving defoamed lubricant oil from the oil jacket 8. Oil that collects in the oil jacket 8 would be delivered into Spangenberg's crank case oil reservoir, as opposed to an oil supply container that is separate from Spangenberg's crank case oil reservoir.

Finally, incorporating Krotky's cylinder block into Spangenberg's lubricating system would not yield an "oil suction line of the oil return pump [that] delivers lubricant oil into the annular space," as recited in claim 7, because oil is not directly conveyed into Krotky's oil jacket 8 by a pump. Moreover, Krotky's oil jacket 8 does not include provisions for receiving oil from an oil return pump.

Accordingly, because claim 7 includes features that are neither disclosed nor suggested by Spangenberg and/or Krotky, *prima facie* obviousness cannot be established based on the cited references. Claims 8 and 11-13 are dependent upon claim 7, and therefore should also be allowed at least as being dependent upon an allowable base claim. Reconsideration of claims 7, 8 and 11-13 is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spangenberg (U.S. Patent No. 2,443,875) as modified by Krotky et al. (U.S. Patent No. 5,842,447), and further in view of Udagawa (U.S. Patent No. 5,215,316). Claim 9 depends from claim 7, which recites several features that are neither disclosed nor suggested by Spangenberg, Krotky and/or Udagawa. As explained above, Spangenberg and Krotky, considered either alone or in combination, fail to disclose or suggest several features of claim

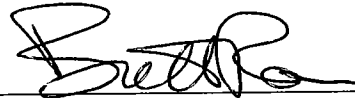
7. Udagawa fails to overcome the deficiencies of the Spangenberger and Krotky references as they relate to claim 7. Reconsideration of claim 9 is respectfully requested.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spangenberger (U.S. Patent No. 2,443,875) as modified by Krotky et al. (U.S. Patent No. 5,842,447), and further in view of Edwards (U.S. Patent No. 2,575,315). Claim 10 has been cancelled without prejudice or disclaimer of the subject matter thereof.

**Conclusion**

In view of the amendments in the claims and the remarks set forth above, Applicants respectfully submit that this application is now in condition for allowance, which action is respectfully requested. If the Examiner believes an interview will advance the prosecution of this application, it is respectfully requested that the Examiner contact the undersigned to arrange the same.

Respectfully submitted,



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